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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,366	09/01/2005	Roger Braun	05-374	2649
34704 7590 01/04/2011 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510				
EXAMINER				
TRAN, THAO T				
ART UNIT		PAPER NUMBER		
1787				
MAIL DATE		DELIVERY MODE		
01/04/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,366

**Applicant(s)**

BRAUN ET AL.

**Examiner**

Thao T. Tran

**Art Unit**

1787

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-49 and 51-89 is/are pending in the application.
- 4a) Of the above claim(s) 72-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-49, 51-71 and 87-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/08/2010 has been entered.
2. Claims 31-49, 51-89 are currently pending in this application. Claim 89 has been newly added. Claims 72-86 have been previously withdrawn with traverse.
3. The previous rejection is maintained as set forth below.

#### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 31-49, 51-71 and 87-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Aydin et al. (US Pat. 4,980,404).

Aydin discloses a one-component adhesive composition, comprising an aqueous dispersion of a copolymer containing (meth)acrylate and vinyl esters and has a glass transition temperature of up to 40°C. The vinyl esters used include vinyl acetate (see col. 2, ln. 8-34, ln. 56-57).

Examples 1-5 show that after being applied to silicone paper, the dispersion is dried in the air for 3 minutes. After which, a woven cotton fabric is placed in the still moist adhesive layer and the adhesive is dried at room temperature, indicating that the moisture has been reduced to an equilibrium point. Aydin further discloses that other resins such as hydrocarbon resins and rosin derivatives may be added to the dispersion to improve the adhesive properties (see col. 3, ln. 57-60), and the adhesive composition has a long shelf life (see col. 3, ln. 57-64). The hydrocarbon and rosin resins are conventionally known as tackifiers, indicating that the adhesive composition can be sufficient without the addition of these resins. And the fact that the adhesive composition has a long shelf life and can be dried at room temperature illustrates that it has enduring adhesion properties which appear to read on the presently claimed properties of "being block-free" and static friction.

Moreover, since the reference teaches the same adhesive composition, it would inherently have the same chemical and physical properties as presently claimed. It is further noted that in a product claim, determination of patentability depends on the chemical or structural elements and not properties of the product.

The burden is on Applicants to conclusively demonstrate that the product as claimed is patentably distinct from the product of the prior art by showing that the composition is different from the prior art in its chemical components to impart the difference in its properties.

Aydin further teaches that the shelf life of the adhesive is not less than 6 months (see col. 1, ln. 46-52).

Note that to patentably distinguish from the prior art, it is necessary for Applicants to show that the chemical components in the composition are different from the prior art, not just the properties without the chemical components included in the claim.

### **Response to Arguments**

6. Applicant's arguments and Affidavit filed on 11/08/2010 have been fully considered but they are not persuasive.

In response to Applicants' argument that the Aydin reference does not disclose a block-free adhesive, or a static friction of at least about 1 N/mm<sup>2</sup>, as mentioned above and previously, since Aydin discloses all the same chemical components in the adhesive composition, the adhesive composition of Aydin would inherently have the same properties as claimed.

Note that Aydin also discloses the adhesive having a shelf life no less than 6 months, which appears to read on the presently claimed property.

Note that to patentably distinguish from the prior art, Applicants must show that the composition is different from the prior art in its chemical components to impart the difference in its properties, and not just the properties only.

### **Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Thao T. Tran/  
Primary Examiner, Art Unit 1787

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